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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,027	11/02/2000	Hideshi Hattori	TJK/134	6830

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EXAMINER

PARKER, FREDERICK JOHN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/705,027

Applicant(s)

HATTORI, HIDESHI

Examiner

Frederick J. Parker

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): claim objections to 1,21.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

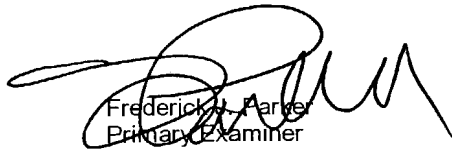
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 21 and 22.

Claim(s) objected to: _____

Claim(s) rejected: 1-13 & 23.Claim(s) withdrawn from consideration: 14-20.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Frederick J. Parker
Primary Examiner
Art Unit: 1762

Continuation of 5. does NOT place the application in condition for allowance because: Applicants cite as support for the amendment of claim 1 which the Examiner previously cited as New Matter the graph of figure 9 which depicts (see spec page 49) saturated composite film versus initial polymer film for three different materials each represented as a different symbol. How does this support the limitation that the formed polymeric layer "has a thickness that is at least equal to .04 microns"? The figure not only shows values only for one specific material at what arguably might be .04 microns but the figure expressly shows NO VALUES EXCEEDING ABOUT .6 MICRONS so figure 9 sets a concrete upper goal whereas the limitation is open ended by virtue of the phrase "at least equal to .04 microns", which including 25, 50 5000, etc microns which clearly is unsupportable. Further, the explanation is not commensurate with scope of claims because the claim is for "a polymeric material" and figure 9 is valid for only 3 very specific polymers. The Examiner has no reason to believe the figure is valid for ALL polymeric layer materials. Applicants arguments are not persuasive and the New Matter rejection is maintained.

As to the point the thickness on column 4 of Adair refers only to the diamonds, the Examiner believes this includes the polymeric layer which clearly could not exceed the thickness of the diamonds or the intent of the invention would have been defeated, as would have been apparent to the reader of ordinary skill. Regardless, Applicants' limitation of a polymeric thickness which is at least equal to .04 microns is unsupported New Matter as explained above.